PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#22/Election
P. 4
1/22/03

In re Application of :

Dr. Chai-Mei Tang : Patent Art Unit: 2882

Serial No.: 09/734,761 : Examiner: C. Church

Filed: 13 December, 2000 :

For: TWO-DIMENSIONAL, ANTI-SCATTER GRID AND COLLIMATOR DESIGNS, AND ITS MOTION, FABRICATION AND ASSEMBLY :

AMENDMENT AND RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REMARKS

This is in response to the December 16, 2002 Office action restricting this application to Group I, including claims 1-4, 6-36, 43-45 and 70-72 directed to the x-ray scatter grids and methods of using the same, and Group II, including claims 37-42 and 46-69, directed to photolithography methods. It is respectfully asserted that the Examiner has inadvertently failed to address claims 73-75, and it is believed that those claims should be grouped with the Group II claims.

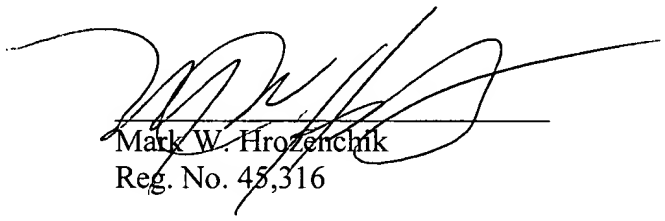
Applicant provisionally elects the claims of Group I which include the x-ray scatter grids and methods of using the same, claims 1-4, 6-36, 43-45 and 70-72 with traverse. Applicant respectfully submits that the restriction is improper and should be withdrawn. Specifically, Applicant notes that this restriction comes after the filing of a request for

continued examination, in which thirty (30) claims were added. However, several of the claims (including independent claims 37 and 43) that the Examiner has restricted into Group II have already been the subject of several Office actions by the Examiner, and hence, have been subject to a search. Therefore, the Applicant respectfully submits that this restriction is not timely as required by 37 CFR 1.142(a): "[i]f the distinctiveness and independence of the invention be clear, such requirement will be made *before* any action on the merits . . ." 37 CFR 1.142(a) (emphasis added). Although Rule 142(a) states that a restriction may be made at any time before final action in the case at the discretion of the Examiner, the rule further states that "the examiner should make a proper requirement *as early as possible in the prosecution*", and "in the first action if possible." Also, MPEP Section 811 states that "[b]efore making any restriction requirement *after* the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." (emphasis added). Applicant respectfully submits that the timeliness of the restriction has passed, as the original set of claims already contained claims 37-42 which are now being restricted into Group II claims. Furthermore, the Applicant submits, as discussed in greater detail below, there cannot be a serious burden on the Examiner because the Examiner has already searched the corresponding class in which the Group II claims are classified.

Furthermore, Applicants submit that since a search of claims 37-42 of Group II has already been performed, Applicant notes that "[i]f the search and examination of the entire application can be made *without* serious burden, the Examiner *must* examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP §803 (emphasis added).

For all these reasons, Applicant respectfully requests that the Examiner consider all claims on the merits, and early and favorable action is respectfully requested.

Respectfully submitted,



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